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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,604	03/13/2000	John H. Norris	112789A	7369
7590	11/17/2003			
Samuel H Dworetsky AT&T Corp P O Box 4110 Middletown, NJ 07748-4110			EXAMINER PEZZLO, JOHN	
			ART UNIT 2662	PAPER NUMBER
			DATE MAILED: 11/17/2003	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/523,604

Applicant(s)
Norris et al.

Examiner
John Pezzlo

Art Unit
2662



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 Jun 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 and 42-57 and 26-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 15, 29, and 40 of U.S. Patent No. 6,353,611 B1 and claims 1 and 14 of U.S. Patent No. 5,805,587. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because of the following:

1. Regarding claims 1, 42, and 57 of the instant application with respect to claims 1, 15, 29, and 40 of US 6,353,611 B1 and claims 1 and 14 of US 5,805,587. Claims 1, 42 and 57 of the instant application merely broadens the scope of the claims 1, 15, 29, and 40 of US 6,353,611 and claims 1 and 14 of US 5,805,587 by eliminating the elements and their functions of the claims. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969), omission of a reference element whose function is not needed would be obvious to one skilled in the art.

2. Regarding claim 16 of the instant application with respect to claims 1, 15, 29, and 40 of US 6,353,611 B1 and claims 1 and 14 of US 5,805,587. Both the instant application and the patents are directed to directing a call to a data terminal if the called party is connected to the Internet after the calling party has initiated a call to the telephone line of the calling party.

The references do not expressly disclose receiving a message from the calling party prior to connecting the call to the data terminal.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the device receives a message. The suggestion/motivation for doing so would have been

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that the references direct the call to the data terminal and receiving a message from the called party is an indication which can be used to direct the call to the data terminal.

3. Regarding claims 26 and 34 of the instant application with respect to claims 1, 15, 29, and 40 of US 6,353,611 B1 and claims 1 and 14 of US 5,805,587. Both the instant application and the patents are directed to directing a call if the called party is connected to the Internet after the calling party has initiated a call to the telephone line of the calling party.

The references do not expressly disclose directing the call to a voice mail server or terminating the call.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the device would provide the calling party the options to store a message for the called party or terminate the call. The suggestion/motivation for doing so would have been that the device would provide additional services to the calling party which would increase sales and profits while being services that are part of the PSTN options.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Pezzlo whose telephone number is (703) 306-5420. The examiner can normally be reached on Monday to Friday from 8:30 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C.

or faxed to:

(703) 872-9306

For informal or draft communications, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Receptionist (Sixth floor)


Crystal Park 2

2121 Crystal Drive

Arlington, VA.

John Pezzlo

11 November 2003


JOHN PEZZLO
PRIMARY EXAMINER